

Notice of Allowability

Application No.

10/069,338

Examiner

Marc S. Zimmer

Applicant(s)

RODDIS, JAMES

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to May 5, 2004 and the telephone interview conducted on July 15, 2004.
2. ☒ The allowed claim(s) is/are 1,2,4-7,10-12,14-19 and 27-32.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Claim Numbering

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Applicant has mischaracterized the status of claim 26 as cancelled. However, there was not previously any presentation of a claim 26. Therefore, the new claims submitted May 5, 2004 should have been numbered starting with 26. Misnumbered claim 27-32 been renumbered 26-31. Any mention of these claims hereinafter will be according to this corrected numbering scheme.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Marina Schneller on July 15, 2004.

The application has been amended as follows:

In claim 1, lines 4 and 5 replace ", wherein the glass composite matrix comprises glass granules of" with

-- which have a --.

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In claim 2, lines 4 and 5 replace “, wherein the glass composite matrix comprises glass granules of” with

-- which have a --.

Also in claim 2, please insert the word

-- and --

after “4mm-6mm”.

In claim 5, lines 4 and 5 please remove “, wherein the glass composite matrix comprises glass granules of”.

Please cancel claims 8 and 9.

In claims 11 and 12, lines 4 and 5 remove “, wherein the glass composite matrix comprises glass granules of” and insert the word

-- a --

before “grain size”.

In claim 17, please replace the period at the end of the claim with

-- wherein the solid glass composite matrix comprises more than 60% w/w of glass granules which have a grain size of 4mm-6mm. --

In a telephone interview with Applicant, it was pointed out that the amendments made of record in their response dated May 5, 2004 were not adequate to overcome the art as the Examiner viewed the limitations that

- (i) the matrix was comprised of more than 60% w/w/ of glass granules and
- (ii) the matrix comprised glass granules having grain size 4mm-6mm

as independent of one another. That is, the claim construction was such that not all of the at least 60% by weight glass granules were necessarily of the mandated particle size. In these circumstances, Hyodo would still have been considered to constitute a valid grounds of rejection. However, because the Examiner suspected that this had been the intention of Applicant to link these limitations, Ms. Schneller was contacted to see if alternative language could be negotiated that would better articulate the premise that all of the 60+ wt% of the glass granules had a particle size of 4mm to 6mm. The above amendments accomplish this endeavor.

In a separate matter, Applicant informed the Examiner of two Information Disclosure Statements that had been recently filed. It is noted that these submissions had not formally been matched with the case as of the date that this correspondence was written hence the Examiner will not comment on the validity of these references at this time.

Allowable Subject Matter

The prior art is replete with examples of glass granule-containing polymer composites. That being said, there is no evidence that a composite having a polymer binder and the required amount of granules with the specified particle size had been previously contemplated. In most instances, the granules were substantially smaller or were incorporated as a much broader particle size distribution. The documents already cited, and *Hyodo* in particular still represent the most germane art available. Insofar as these documents no longer even render obvious the claimed invention, claims 1-2, 4-7, 10-12, 14-19, and 27-32 are deemed allowable.

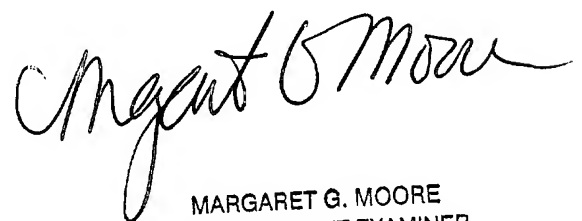
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 15, 2004



MARGARET G. MOORE
PRIMARY PATENT EXAMINER
ART UNIT 1712